

## REMARKS

This Response to Office Action is submitted in response to the Office Action dated August 12, 2002. The specification has been amended for clarification purposes only. Claims 1, 5, 14, 23 and 26 have also been amended. Claim 6 has been cancelled without prejudice or disclaimer. New Claims 33 to 48 have been added. No new matter has been added.

A Petition for a three-month Extension of Time to Respond to the Office is submitted herewith. Checks in the amount of \$1,526.00 and \$110.00 are submitted herewith to cover the cost of the three-month extension, the additional claims and the Terminal Disclaimer.

The Examiner objected to the drawings under 37 CFR 1.83(a) as not including the elements disclosed in Claim 9. The Examiner rejected Claim 9 under 35 U.S.C. § 112 as containing subject matter which was not described in the specification. Claim 9 has been amended to clarify the claim, is non-narrowing and disclaims no subject matter. It is respectfully submitted that the amendment places the claim and drawings in proper form.

Claims 10 to 12, 18 and 19 were rejected provisionally under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 15 to 34 of copending Application No. 09/689,510. Applicants submit herewith a timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c). It is respectfully submitted that the Terminal Disclaimer overcomes the Examiner's double patenting rejection.

Claims 1 to 9, 14, 16, 22 and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,312,344 to Yoseloff ("*Yoseloff*"). Claims 8, 13 and 25 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Yoseloff* and in view of U.S. Patent No. 6,398,218 to Vancura ("*Vancura*"). Claims 10 to 12, 18 to 21 and 24 to 32 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Yoseloff* and Schwartz et al., *The Encyclopedia of TV Game Shows*, 3<sup>rd</sup> Edition, Checkmark Books (1999) ("*Encyclopedia*"). Claims 10 to 12, 18 and 19 were also rejected in view of an Affidavit provided by Examiner Corbett Coburn ("*Affidavit*").

Claim 1 as amended is directed to a method for operating a gaming device. The method includes the steps of: (i) providing an initial sequence that includes at least one player decision, the decision resulting in a successful outcome or an unsuccessful outcome; (ii) enabling the player to input the player decision into a processor of the gaming device; (iii) determining if the decision produces the successful outcome or the unsuccessful outcome in the initial sequence; (iv) providing an award to the player if the decision produces the successful outcome; and (v) enabling the player to advance to a further sequence of the gaming device if the decision produces the successful outcome, wherein the further sequence includes a different method of play than the initial sequence and the further sequence compares the award to at least one other value to determine whether to provide the player a higher award than the award from the initial sequence. Claim 1 as amended is patentably distinguished over *Yoseloff*.

*Yoseloff* does not teach the combination of elements recited in Claim 1 as amended. In particular, *Yoseloff* does not teach enabling the player to advance to a further or second sequence of the gaming device, where the further sequence includes comparing an award produced via a successful outcome of a player's decision in an initial sequence to another value to determine whether to provide the player a high award. *Yoseloff* does not disclose, teach or suggest a game that compares the award provided in the initial sequence to another value. *Yoseloff* discloses in connection with Fig. 6 a selection game where various selections can modify the player's award or wager causing a loss of the wager, a push or a gain. No comparison of the award takes place. There is, therefore, no teaching of an award comparison and, therefore, there is no teaching of the combination of elements of Claim 1, which includes the award comparison. Applicants therefore respectfully submit that Claim 1 as amended and Claims 2 to 4 which depend respectively therefrom are each in condition for allowance.

Claim 2 provides an additional patentable feature over *Yoseloff*. Although *Yoseloff* discloses at column 3, lines 10-20, arranging the various games in the different order, *Yoseloff* does not disclose in any particular method selecting from a plurality of initial sequences as included in Claim 2. Claim 2, therefore, provides an additional patentable feature over *Yoseloff*.

Claim 3 also provides an additional patentable feature over *Yoseloff*. Claim 3 includes providing a consolation award to the player if the player's decision produces an unsuccessful outcome. The Office Action asserts that *Yoseloff* teaches a consolation award at column 6, lines 6-17. This section, however, discusses the outcome of the second game segment of *Yoseloff*. Claim 3 on the other hand, includes providing a consolation award to the player if the player does not achieve or reach a second (analogous) game segment. Claim 4 also includes the element of providing a consolation award. Claims 3 and 4, therefore, each provide additional patentable features over *Yoseloff*.

Claim 5 as amended is directed to a method for operating an award exchange sequence in a gaming device. The method includes the step of associating a high value award with a first selector or a second selector. The high value award is greater than an award currently held by the player. A low value award is associated with the selector not associated with the high value award. The low value award is less than the player award. The player is enabled to keep the player award or choose one of the two selectors. The method includes providing the player award to the player if the player keeps the player award. The low value award is provided to the player if the player chooses the selector associated with the low value award. The high value award is provided to the player if the player chooses the selector associated with the high value award. Also, if the player chooses the selector associated with the high value award, the previous steps are repeated at least one time using the provided high value award, where the high and low value awards in the repeated steps are modified to be greater and less, respectively, than the high value award.

*Yoseloff* does not teach the steps of Claim 5 as amended. In particular, *Yoseloff* does not repeat the same gaming event, using awards or values modified via a previously played gaming event. As illustrated in column 3, lines 1-18, *Yoseloff* discloses arranging different game segments, A, B, C and D, in various orders. *Yoseloff* does not, however, teach playing game segment A twice in a row. Indeed, at column 6, line 1, *Yoseloff* states, "at the conclusion of play of the second segment 26 which has a visually different screen format than play of the first segment 6, . . .". *Yoseloff* indeed teaches away from the elements of Claim 5 as amended. Applicants respectfully submit

that Claim 5 as amended and Claims 6 to 13 that depend respectively therefrom are each novel, non-obvious and patentably distinguished over *Yoseloff* and in condition for allowance.

Because *Yoseloff* does not teach repeating the same steps, *Yoseloff* cannot teach the further elements of repeating the same steps as included in Claim 7 to 9. Claims 7 to 9 provide additional patentable features over *Yoseloff*.

The patentability of independent Claim 5 renders the obviousness rejection of Claims 8 and 13 in view of *Yoseloff* and *Vancura* moot. Moreover, *Vancura* does not teach providing at least two selections with high values and at least two selections with low values as included in Claim 13. The cited portion of *Vancura*, namely column 12, lines 47-54, in connection with Fig. 1, instead includes a discussion of a number of slot machine reels, not a number of selections as required by the claim. Claim 13 provides additional patentable features over *Yoseloff* and *Vancura*.

Claim 14 as amended is directed to a method of operating an award exchange sequence in a gaming device. The method includes the steps of: (i) enabling a player to input into a processor a decision to keep a currently held award or to input a decision to risk losing the award to try for an award exchange, wherein the decision produces a successful outcome or an unsuccessful outcome; (ii) ending the sequence if the player inputs the decision to keep the currently held award; and (iii) determining whether the successful or the unsuccessful outcome occurred if the player inputs the decision to try for the award exchange, the successful outcome occurring when an award selected by the player has a higher value than the currently held award; and (iv) continuing the sequence when the successful outcome occurs and not continuing the sequence when the unsuccessful outcome occurs.

*Yoseloff* does not teach the combination of elements of Claim 14 as amended. In particular, *Yoseloff* does not teach comparing an award selected by the player with an award currently held by the player and providing a successful outcome if the award selected by the player has a higher value than the currently held award. As stated above, *Yoseloff*, in connection with Fig. 6, includes modifying the player's wager. No award comparison occurs in *Yoseloff*. Furthermore, the various different types of games that *Yoseloff* discusses using, such as poker, dominos and blackjack, do not

compare a value selected by the player to see if it is higher or lower than an award currently held by the player.

Furthermore, *Yoseloff* does not teach continuing the game sequence when a successful outcome occurs, wherein the successful outcome occurs due to a favorable comparison between a player selected award and an award currently held the player. Accordingly, Claim 14, as amended, Claims 15 to 25 and Claims 33 to 34 that depend respectively therefrom, are each novel, non-obvious and distinguished patentably over *Yoseloff* and are each in condition for allowance. The amendment to Claim 14 also renders the rejection of Claims 18 to 21 in view of *Yoseloff* and *Encyclopedia* moot.

The combination of *Yoseloff* and *Encyclopedia* does not teach or suggest the method of Claims 23 to 25. That is, neither reference teaches repeating the award exchange steps when the successful outcome occurs. Claims 23 to 25 provide additional patentable features over the combination of references *Yoseloff* and *Encyclopedia*. It should be noted that Claims 23 to 25 have been amended solely for the purpose of having language consistent with the language of Claim 14 as amended. The amendments to Claims 23 to 25 are non-statutory, non-narrowing and disclaim no subject matter.

Claim 26 as amended is directed to a method for operating a player tease sequence in a gaming device. The method includes the steps of: (i) after accepting an input designating a player's decision to risk a known, currently held award to try for a higher value award exchange, increasing the currently held award by at least one increment randomly determined from at least one predetermined range; (ii) without revealing a determination of the player's success, enabling the player to input into a processor a decision to keep the increased award or to input into the processor a decision to risk losing the increased award to try for the higher value award exchange; and (iii) ending the sequence if the player inputs the decision to keep the increased award.

*Yoseloff* and *Encyclopedia* do not teach a combination of elements of Claim 26 as amended. In particular, neither reference discloses using an increment randomly determined from a predetermined range. *Encyclopedia* and the Affidavit submitted in connection therewith do not disclose providing a range of increments, wherein one of

the increments is randomly selected from the range and added to a player's award after the player chooses to risk the award. Accordingly, Applicants submit respectfully that Claim 26 as amended and Claims 27 to 32 are distinguished patentably over *Yoseloff*, *Encyclopedia* and the Affidavit.

Moreover, the references do not disclose repeating the steps of the method, wherein each repetition includes determining a tease increment from a range as included in Claims 27 and 28, respectively. These claims provide additional patentable features over *Yoseloff*, *Encyclopedia* and the Affidavit.

New Claims 35 to 48 each include elements and combinations of elements that are not found in *Yoseloff*, *Vancura*, *Encyclopedia* and the Affidavit. These claims include elements which are not found and which are contrary to the Let's Make a Deal TV show games disclosed in the references of record. It is respectfully submitted that these claims are also in condition for allowance.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

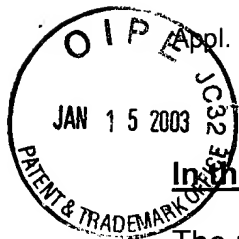
An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Specification:**

The paragraph beginning at page 3, line 5 has been amended as follows:

In the first known game, the "go-until" or "do-until" bonus round can end quite quickly if the player selects a terminator early in the bonus round. The player blindly selects masked awards until selecting the bonus terminator, which is immediately displayed. The player knows nothing about the location of any particular award, and there is no logical incentive to select any particular masked award as opposed to any ~~another~~ other masked award. Choosing a masked award also poses no risk to a previously accumulated award. That is, there is not incentive to stop selecting. The only logical course is for the player to continue selecting until selecting a terminator. The player's involvement in the bonus round and thus the player's level of enjoyment and excitement from the bonus round is thus limited.

The paragraph beginning at page 5, line 2 has been amended as follows:

The present invention provides a method for operation of a gaming device and preferably a bonus round of said device, whereby the player can selectively keep an award or attempt to sequentially exchange or trade up to a point or award total that enables the player to obtain a final and desirable ultimate award. The present invention can disclose the value of the ultimate award, and in either case the player knows the existence of the ultimate award. The present invention preferably discloses or reveals the value of the player's currently held or currently obtained award. The player preferably knows that there is an ultimate award the player has an opportunity to obtain and preferably knows the award the player must risk to obtain the ultimate award. The game can reveal the value of the intermediate award steps as the player decides to go for the ultimate award or settle for the currently held award. The game preferably provides a consolation award to a player upon an unsuccessful exchange and one or more tease sequences described below.

The paragraph beginning at page 6, line 6 has been amended as follows:

If the player succeeds at the initiator game, the game preferably provides the player with an award that becomes the initial currently held award in the main award exchange sequence of the present invention. The award exchange sequence involves the player successively risking the currently held award for opportunities to trade up to higher and higher awards in order to and reach an ultimate award. The player can stop at any point in the succession and keep the currently held award, at which point, the game or the bonus round preferably ends. If the player is unsuccessful in an attempt to trade up, the game preferably provides the player with a consolation award.

The paragraph beginning at page 15, line 10 has been amended as follows:

The present invention can be employed as a bonus round in a gaming device or a primary game in a gaming device. The main difference between the two is that in a primary game, the player can win nothing. In a bonus round, the game preferably provides at least some consolation award to the player. The present invention is preferably a bonus round of a gaming device and is thus described as such. The present invention, however, is not so limited and can be employed as a primary game in a gaming device.

The paragraph beginning at page 17, line 17 has been amended as follows:

The database of Fig. 4 includes a column 62 having three current player award ranges 25-100, 400-500 and 700-1000. These ranges include the player's currently held award for the beginning of an exchange sequence. The column 64 includes three corresponding consolation awards 20, 100 and 300. The game awards the consolation values when the player unsuccessfully attempts to exchange or upgrade the current award. The column 64 66 includes three upgrade award ranges 400-500, 700-1000 and 1500-3000. The game upgrades or exchanges the player's current award with an upgrade award from the corresponding range upon a successful exchange. The upgrade range from a preceding row, e.g., row 76, thus becomes the player's current range in a succeeding row, e.g., row 78. The upgrade range of the final row 80 includes the ultimate award, i.e., 3000.



The paragraph beginning at page 18, line 12 has been amended as follows:

Referring now to Fig. 5, a process flow diagram of an indicator sequence of the present invention is illustrated. Upon a bonus round triggering event, indicated by the oval 82, the game randomly selects one of three initiator games for the player to play, as indicated by the block 84. The game can equally weight the changes of picking any particular initiator game or assign a weighted percentage to each. The game can make such determination at any prior point of the bonus round or base game of the gaming device. The present invention can store any number of initiator games and can employ multiple initiator games during any given bonus round.

The paragraph beginning at page 22, line 6 has been amended as follows:

As indicated by the block 116, the player wins the award upgrade, which the game sets to the player's current award in the next award exchange sequence. The game selects two new values from the next award upgrade row of the database of Fig. 4 and randomly assigns each value to one of the symbols "A", "B" or "C" illustrated in Fig. 3. The game selects the consolation award from the next consolation row of the database of Fig. 4 and assigns it to the remaining unassigned symbol "A", "B" or "C". The game then returns the player to instructional prompt indicated by block 100. The preferred award exchange sequence continues until the sequence ends as indicated by ovals 104, 114 or in ovals contained in the tease sequence of Fig. 7.

The paragraph beginning at page 25, line 3 has been amended as follows:

Referring again to Fig. 4, the sample database of the present invention illustrates four incremental tease awards 68,70,72 and 74 with each row, namely, rows 76, 78 and 80. The present invention contemplates providing any number of possible incremental tease awards. The present invention also contemplates randomly selecting and adding less than all of the tease awards to the player's current award. Although not illustrated, the game can maintain a tease probability distribution, for example, a 10% chance that the game adds only the first tease, a 40% chance that the game adds on the first and second teases, a 40% chance that the game adds the first, second and third teases and a 20% chance that the game adds all four teases.

The paragraph beginning at page 27, line 2 has been amended as follows:

Referring now to Fig. 8, an enlarged front plan view of the display device generally is shown displaying the components of an alternative award exchange embodiment of the present invention. In Fig. 8, like in Fig. 3, the display device 32 preferably includes a touch screen 46 and an associated touch screen controller 48 discussed in Fig. 2. The alternative embodiment also provides the keep selector and indicator 52, which updates and displays the value of the player's current award. In Fig. 8, unlike like Fig. 3, the game only provides the two selectors 54 and 56, which as before are associated with the symbols "A" and "B", respectively. The game also preferably provides a suitable visual and/or audio prompt 138, which now directs the player to keep a current award by selecting the keep button 52 or exchange it for one of the two prizes associated with symbols "A" or "B".

The paragraph beginning at page 31, line 6 has been amended as follows:

Second, diamond 132 in which the game determines whether another award upgrade exists is not applicable in the alternative embodiment because the player has permanently selected the consolation award, i.e., the game ending award. After the revealing the selected and unselected awards in block 130, the game automatically ends and the player ~~who the~~ player who wins the selected consolation award as indicated by the oval 134. In the alternative embodiment, the game does not return to the award exchange sequence from the tease sequence, as indicated by the block 136. In all other respects the tease sequence is the same for the alternative embodiment; namely, the game randomly selects and adds any number of incremental tease awards, as indicated by diamond 126. Again, the present invention preferably varies the number of incremental tease additions so that the game does not become predictable.

**In the Claims:**

Claim 1 has been amended as follows:

1. (Amended) A method for operating a gaming device, said method comprising the steps of:

- (a) providing an initial sequence which includes at least one player decision, said decision resulting in a successful outcome or an unsuccessful outcome for a player;
- (b) enabling said player to input said player decision into a processor of said gaming device;
- (c) determining if said decision produces ~~a successful outcome in said sequence;~~ the successful outcome or the unsuccessful outcome in said initial sequence;
- (d) providing an award to said player if said decision produces the successful outcome; and
- (e) enabling said player to advance to a further sequence of said gaming device if said decision produces the successful outcome, wherein said further sequence includes a different method of play than said initial sequence, and wherein said further sequence ~~utilizes said award~~ compares said award to at least one other value to determine whether to provide the player a higher award than said award.

Claim 5 has been amended as follows:

5. (Amended) A method for operating an award exchange sequence in a gaming device, said method comprising the steps of:

- (a) associating a high value award with either a first selector or a second selector, wherein said high value award is greater than a currently held player award;
- (b) associating a low value award with the selector not associated with the high value award, wherein said low value award is less than said player award;
- (c) enabling said player to keep said player award, choose said first selector or choose said second selector;
- (d) providing said player award to said player if said player keeps said player award;
- (e) providing said low value award to said player if said player chooses the selector associated with said low value award; ~~and~~
- (f) providing said high value award to said player if said player chooses the selector associated with said high value award; and
- (g) if the player chooses the selector associated with the high value award, repeating steps (a) to (f) at least one time using the provided high value award and changing the new associated high and low value awards to be greater and less than, respectively, the provided high value award.

Claim 6 has been cancelled without prejudice or disclaimer.

Claim 14 has been amended as follows:

14. (Amended) A method for operating an award exchange sequence in a gaming device, said method comprising the steps of:

- (a) enabling a player to input into a processor a decision to keep a currently held award or to input into said processor a decision to risk losing said currently held award to try for ~~a higher value~~ an award exchange, and wherein said decision can produce a successful outcome or an unsuccessful outcome for said player in said sequence;
- (b) ending said sequence if said player inputs said decision to keep said currently held award; ~~and~~
- (c) determining whether said successful outcome or said unsuccessful outcome occurred if said player inputs said decision to try for said ~~higher value~~ award exchange, said successful outcome occurring when an award selected by the player has a higher value than the currently held award; and
- (d) continuing the sequence when the successful outcome occurs and not continuing the sequence when the unsuccessful outcome occurs.

Claim 23 has been amended as follows:

23. (Amended) The method of Claim 14, ~~which includes the step of wherein~~ continuing the sequence includes repeating the steps (a) through (c) if said successful outcome occurred.

Claim 24 has been amended as follows:

24. (Amended) The method of Claim ~~14~~<sup>23</sup>, ~~which includes the step of repeating the steps (a) through (c) if said successful outcome occurs;~~ whereby said successful outcome is used to determine said currently held award while repeating said steps.

Claim 25 has been amended as follows:

25. (Amended) The method of Claim 4423, which includes the step of repeating the steps ~~(a) through (c)~~ if said successful outcome occurs, unless said successful outcome includes a highest value award.

Claim 26 has been amended as follows:

26. (Amended) A method for operating a player tease sequence in a gaming device, said method comprising the steps of:

- (a) after accepting an input designating a player's decision to risk a known currently held award to try for a higher value award exchange, increasing said currently held award by at least one increment randomly determined from at least one predetermined range;
- (b) without revealing a determination of said player's success, enabling said player to input into a processor a decision to keep said increased award or to input into said processor a decision to risk losing said increased award to try for said higher value award exchange; and
- (c) ending said tease sequence if said player inputs said decision to keep said increased award.

New Claims 33 to 48 have been added.